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Patent  
Attorney's Docket No. 026350-058

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	
	)	
Yoji SAKAGAMI et al.	)	Group Art Unit: 1638
	)	
Application No.: 09/880,006	)	Examiner: Russell Kallis
	)	
Filed: June 14, 2001	)	Confirmation No.: 4690
	)	
For: A PROMOTER DERIVED FROM	)	
PHYTOSULFOKINE PRECURSOR	)	
GENE	)	

**RESPONSE TO REQUIREMENT FOR RESTRICTION**  
**TRANSMITTAL LETTER**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Enclosed is a Response to Requirement for Restriction for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and a check for ☐ \$55.00 (2814) ☐ \$110.00 (1814) to cover the requisite Government fee are also enclosed.
- ☐ Also enclosed is \_\_\_\_\_.
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$370.00 (2801) ☐ \$740.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) previously submitted \_\_\_, on \_\_\_, for which continued examination is requested.
- ☐ Applicant(s) request suspension of action by the Office until at least \_\_\_, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.

☐ No additional claim fee is required.

☐ An additional claim fee is required, and is calculated as shown below:

A M E N D E D   C L A I M S					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× \$18.00 (1202) =	
Independent Claims		MINUS =		× \$84.00 (1201) =	
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
<b>TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT</b>					

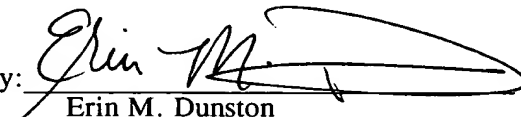
☐ A claim fee in the amount of \$\_\_\_\_\_ is enclosed.

☐ Charge \$\_\_\_\_\_ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

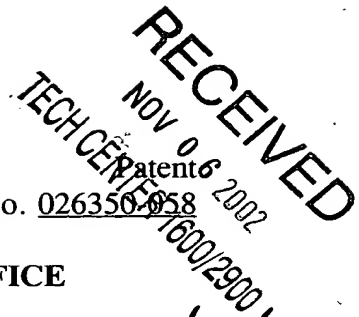
Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:   
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Date: November 4, 2002



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Yoji SAKAGAMI et al ) Group Art Unit: 1638  
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RESPONSE TO REQUIREMENT FOR RESTRICTION

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In complete response to the Official Action mailed October 3, 2002 (Requirement for Restriction), Applicants elect Group I (*i.e.*, Claims 1, 12, 15, 18, and 21, relating to SEQ ID. 1), with traverse.

Applicants traverse the election for at least the following reasons. M.P.E.P. § 803 states that an application may be properly restricted to one or more claimed inventions *only if* (1) the inventions are independent or distinct as claimed; *and* (2) there is a serious burden on the Examiner if the Restriction is not required. Thus, even if appropriate reasons exist for requiring restriction, such a Restriction should not be made unless there is an *undue burden* on the Examiner to examine all of the claims.

Applicants respectfully traverse the Restriction Requirement with respect to Groups I to V because there would be no undue burden in examining these Groups together and because the Examiner has provided no explanation of how undue burden may arise. The Examiner merely asserts that the inventions of Groups I-V are drawn to different DNA

constructs that have different structure and function. *See Official Action, Page 2.*

However, it would seem that a search and examination involved for these Groups would substantially overlap. That is, the claims of Group V pertain to a SEQ ID NO. 5, bases -3359 to +2033; the claims of Group IV pertain to SEQ ID NO. 4, bases -563 to -1; the claims of Group III pertain to SEQ ID NO. 3, bases -1034 to -1; the claims of Group II pertain to SEQ ID NO. 2, bases -1911 to -1; and the claims of Group I pertain to the SEQ ID NO. I, bases -3359 to -1, of a gene encoding a phytosulfokine precursor polypeptide. Accordingly, there is overlap between the Groups and restriction between the Groups is improper. All of the claims of these Groups, and at least the claims of Groups I to IV, should be rejoined.

Moreover, Applicants respectfully traverse the Restriction Requirement with respect to Groups I to V because it limits Applicants to a single sequence. Such a Restriction is improper because it violates the mandate of M.P.E.P. § 803.04, which states:


without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. § 1.141 *et seq.* and permit a **reasonable number of such nucleotide sequences to be claimed in a single application ... normally ten sequences constitute a reasonable number for examination purposes** (emphasis added)

Because the Commissioner has declared that ten sequences are reasonable, Applicants maintain that a mere five, overlapping sequences are certainly reasonable for examination purposes in this case.

Due to at least the reasons presented above, Applicants respectfully request withdrawal of the Restriction Requirement. Further and favorable consideration of all of the claims of record on the merits is respectfully requested.

Should the Examiner wish to discuss any aspect of the present application, he is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:   
Erin M. Dunston  
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